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OFFICE OF PETITIONS

In re Application of :
Jennifa Gosling et al :
Application No. 09/721,341 : DECISION GRANTING PETITION
Filed: November 21, 2000 : UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. 19934-000711US :

This is a decision on the following petitions, filed December 1, 2004:
(1) petition under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee; (2) petition under 37 CFR 1.47, which, for the reasons stated below, is being treated as a petition under 37 CFR 1.183 to waive the requirements of 37 CFR 1.67(b) which requires a supplemental oath or declaration executed by all the named inventors; (3) petition under 37 CFR 1.183 to waive the provisions of 1.48(a)(3) which requires an oath or declaration executed by the actual inventor or inventors as required by § 1.63; and (4) the petition under 37 CFR 1.48(a) to correct the inventorship in the above-identified application.

The petitions are **GRANTED**.

DISCUSSION OF PETITION UNDER 37 CFR 1.313(C)(2)

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on July 22, 2004 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.¹

¹ The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

DISCUSSION OF PETITION UNDER 37 CFR 1.183 TO WAIVE THE PROVISIONS OF 37 CFR 1.67(a)(1)

MPEP § 603 provides that, "[w]hen an inventor who executed the original declaration is refusing or cannot be located to execute a required supplemental declaration, it is possible that the requirement may be suspended or waived in accordance with 37 CFR 1.183." As the inventor who executed the originally submitted declaration is now refusing to execute a supplemental declaration, the submission of a petition under 37 CFR 1.47(a) is not the appropriate avenue of relief in this instance.

Accordingly, the petition under 37 CFR 1.47(a) is being treated as a petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.67(a)(1) which requires a supplemental declaration executed by less than all the named inventors who originally executed a declaration.

Petitioner states that the application papers for this file were mailed to joint inventor Michael Hanley, but were refused delivery. Petitioner further states that Mr. Hanley refused to execute the supplemental declaration due to the fact that he was no longer employed by assignee herein and further would not sign unless he was compensated for executing the declaration. For these reasons, petitioner now requests acceptance of a supplemental declaration without the signature of previously signing inventor joint Michael Hanley.

Under the circumstances recounted in the petition, justice would be served by suspending the requirements of 37 CFR 1.67(a)(1). Accordingly, the declaration received on December 1, 2004 and executed by the named inventors and without the signature of previously signing joint inventor Mr. Hanley is accepted as a proper oath under 37 CFR 1.67(a)(1).

DISCUSSION OF PETITIONS UNDER 37 CFR 1.48(a) AND 37 CFR 1.183 TO WAIVE THE REQUIREMENTS OF 37 CFR 1.48(a)(3)

A petition under 37 CFR 1.48(a) requires:

- (1) A request to correct the inventorship that sets forth the desired inventorship change;
- (2) A statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part;
- (3) An oath or declaration by the actual inventor or inventors as required by § 1.63 or as permitted by §§ 1.42, 1.43 or § 1.47;
- (4) The processing fee set forth in § 1.17(I); and
- (5) If an assignment has been executed by any of the

original named inventors, the written consent of the assignee.

The instant petition seeks to delete Dale Talbot, who through error and without deceptive intent was inadvertently named as an inventor. Accordingly, on petition requesting correction of inventorship pursuant to 35 U.S.C. § 116 and 37 CFR 1.48(a), it has been found that the above-identified application, through error and without deceptive intent, improperly sets forth the inventorship.

As noted above, joint inventor Michael Hanley, who executed the original declaration, now refuses to execute the supplemental declaration. However, for the reasons stated above, justice would be served by suspending the requirements of 37 CFR 1.48(a)(3) which requires the signature of the actual inventor(s) in accordance with 37 CFR 1.63.


The petition has been found to satisfy the requirements of 37 CFR 1.48(a). Accordingly, it is hereby certified that the correct inventorship of this application is:

1. Jennifa Gosling
2. Daniel J. Dairaghi
3. Michael Hanley
4. Zhenhua Miao
5. Thomas J. Schall

A corrected Filing Receipt which sets forth the correct inventorship accompanies this decision on petition.

Telephone inquiries should be directed to the undersigned at (571) 272-3218.

This matter is being referred to Technology Center AU 1647 for processing of the request for continued examination under 37 CFR 1.114.



Brian Heary

Senior Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

ATTACHMENT: Corrected Filing Receipt